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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,557

Applicant(s)

FERRER ET AL.

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 1- 22 have been examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The stated claim cites "interface device adapted to be configurable in such a way as to allow communication of data" where the device has the feature of "device is unable to communicate with or produce data which is intelligible to the second transaction device"

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 22 does not recite that the computer program is encoded or recorded on a physical medium readable by a computer. Thus, the claim is directed to functionally descriptive material that is not functionally or structurally interrelated to the medium. Data structures not claimed as embodied in computer readable media are descriptive material per se and are not statutory because they are neither physical things nor statutory processes. Such claimed data structures do not define any structural and functional interrelationships between the data structure

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, This claim is in improper claim format, there is no preamble which renders the limitations of the claim indistinct.

Claims 8-21 are dependant on Claim 7 and are rejected for at least the same reasons.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 22 is rejected under 35 U.S.C. 102(e) as being unpatentable over Moreau (US Patent No 5,590,196).

As per claim 22,

Moreau ('196) discloses a computer program adapted to translate data and related information derived from a financial transaction, carried out by a first transaction device, into a form which is both suitable for transmission and is intelligible to one or more second financial transaction devices, wherein the translation of the data and related information is predicated on a knowledge of the characteristics and mode

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreau (US Patent No 5,590,196) in view of Shore et al. (US Patent 6,564,193).

As per claim 1,

Moreau ('196) discloses a method of enhancing communication in a financial transaction system, comprising:

carrying out a financial transaction at a first remote location using a first financial transaction device;(Figure 1)

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wherein the translation of the data and related information is predicated on a knowledge of characteristics and a mode of operation of the first transaction device.(Figure 1)

Moreau ('196) does not explicitly disclose translating data and related information derived from the financial transaction into a form which is both suitable for transmission. and is intelligible to at least one second financial transaction device. Shore et al. ('193) discloses translating data and related information derived from the financial transaction into a form which is both suitable for transmission. and is intelligible to at least one second financial transaction device (Column 3, lines 5-8). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Moreau ('196) method with the Shore et al. ('193) method in order to enable the transaction to be processed.

As per claim 2,
Moreau ('196) discloses the method of Claim 1,
wherein the translation of the data and related information occurs in a substantially transparent manner from a point of view of the first transaction device.(Column 5, lines 51-60; Figure 1)

As per claim 3,
Moreau ('196) discloses the method of Claim 1,
Official Notice is taken that "the first transaction device produces or records data which cannot be read directly by, or communicated to the at least one second transaction device" is common and well known in prior art in reference to digital communication. It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate data that could not be read by a secondary device in order to preserve a record of the transaction. The Examiner notes that fax machines commonly generate a usage log, this log would contain data that would not be readable by the receiving machine.

As per claim 4,
Moreau ('196) discloses the method of Claim 1,
wherein the second transaction device is a device associated with at least one entity selected from a group consisting of a financial institution, an administrative institution, an IT service provider, a database, an inventory and management system, and wherein the entities are able to exchange data. (Column 8, lines 11-15)

As per claim 5,
Moreau ('196) discloses the method of Claim 4,
wherein the second transaction device is a server located at an entity.(Figure 1)

As per claim 6,
Moreau ('196) discloses the method of Claim 1,
further comprising updating said translating through of commands sent from the second transaction device.(Figure 1)

As per claim 7,

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Moreau ('196) discloses an interface device adapted to be configurable in such a way as to allow communication of data between a first financial transaction device and at least one second financial transaction device,(Figure 1)

Moreau ('196) does not explicitly disclose wherein the first transaction device is unable to communicate with or produce data which is intelligible to the second transaction device. Shore et al. ('193) discloses wherein the first transaction device is unable to communicate with or produce data which is intelligible to the second transaction device. (Column 6, lines). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Moreau ('196) method with the Shore et al. ('193) method in order to reduce cost of operation by using remote processing.

As per claim 8,

Moreau ('196) discloses the interface device of Claim 7,

Moreau ('196) does not explicitly disclose the first and second financial transaction devices are remote from each other and communicate through a network Shore et al. ('193) discloses the first and second financial transaction devices are remote from each other and communicate through a network (Figure 1). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Moreau ('196) method with the Shore et al. ('193) method in order to reduce cost of operation by using remote processing.

As per claim 9,

Moreau ('196) discloses the interface device of Claim 7,

wherein the at least one second transaction device is a server located at a location of an entity selected from a group consisting of a financial institution, an administrative institution, an IT service provider, a database, an inventory and management system.(Column 8, lines 11-15)

As per claim 10,

Moreau ('196) discloses the interface device of Claim 7,

Moreau ('196) does not explicitly disclose the interface device is incorporated into the second transaction device. Shore et al. ('193) discloses the interface device is incorporated into the second transaction device. (Figure 4). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Moreau ('196) method with the Shore et al. ('193) method in order to allow consumers to access the device.

As per claim 11,

Moreau ('196) discloses the interface device of Claim 7,

Official Notice is taken that "the interface device is remotely configurable in response to a determination of the nature and characteristics of the first transaction device" is common and well known in prior art in reference to digital communication. It would have been obvious to one having ordinary skill in the art at the time the invention was made to maintain remote configuration files in order to reduce the cost of administration by centrally locating all of the maintenance software.

As per claim 12,

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Moreau ('196) discloses the interface device of Claim 7, wherein the interface device corresponds to a computer configured to receive financial transaction data from the first transaction device, to convert the data into a form which can be communicated to and understood by the second transaction device.(Figure 1)

As per claim 13,
Moreau ('196) discloses the interface device of Claim 7, wherein the first transaction device corresponds to a 'legacy' device which is inherently unable to communicate with an external financial transaction network or provide data which is intelligible to the one or more second transaction device.(Figure 1)

As per claim 14,
Moreau ('196) discloses the interface device of Claim 7, wherein the second transaction device is in the form of one or more servers carrying out functions of at least one of the entities.(Figure 1)

As per claim 15,
Moreau ('196) discloses the interface device of Claim 7,
Moreau ('196) does not explicitly disclose the network comprises the Internet. Shore et al. ('193) discloses the network comprises the Internet (Figure 1). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Moreau ('196) method with the Shore et al. ('193) method in order to reduce cost of operation by using the Internet, for low cost communications.

As per claim 16,
Moreau ('196) discloses the interface device of Claim 7, wherein the at least one second transaction device communicates with the first transaction device via a medium selected from a group consisting of dial-up connection and a permanent connection, wherein the medium provides for communication on substantially real-time basis.(Figure 1)

As per claim 17,
Moreau ('196) discloses the interface device of Claim 7, wherein the first transaction device comprises a device selected from a group consisting of a PINpad, a swipe card unit, a processor, a report generation means, and a manual entry keypad.(Figure 1)

As per claim 18,
Moreau ('196) discloses the interface device of Claim 7, wherein the interface device is adapted to differentiate data from a range of financial transactions capable of being carried out on the first transaction device, the transactions being selected from a group consisting of debit processes, credit processes, loyalty processes, transmission of alphanumeric sequences, mobile phone communications, barcode reading/transmissions, and funds transaction processes.(Figure 1)

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As per claim 19,

Moreau ('196) discloses the interface device of Claim 7,

Official Notice is taken that "the interface device is configured to operate with a particular first transaction device through configuration files which are maintained and stored on the remote second transaction device/network" is common and well known in prior art in reference to digital communication. It would have been obvious to one having ordinary skill in the art at the time the invention was made to maintain remote configuration files in order to reduce the cost of administration by centrally locating all of the maintenance software.

As per claim 20,

Moreau ('196) discloses the interface device of Claim 7,

wherein the interface device receives data from one or more first transaction devices.(Figure 1)

As per claim 21,

Moreau ('196) discloses the interface device of Claim 7,

wherein the second transaction device includes functionality to allow bi-directional communication between a merchant and a customer using the first transaction device in real-time applying techniques selected from a group consisting of email, fax and WAP.(Figure 1) of operation of the first transaction means.(Figure1)

Conclusion

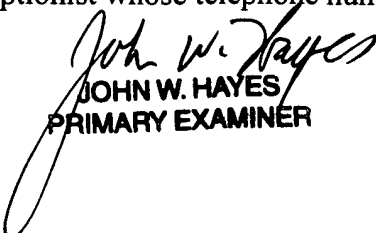
Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

February 22, 2004


JOHN W. HAYES
PRIMARY EXAMINER